

REMARKS

Telephonic Interview

Applicants thank the Examiner for the very helpful telephonic interview of May 17, 2007. In brief summary, the outstanding rejections were discussed, and proposed amendments to the claims were discussed.

If after reviewing this after final response and amendment the Examiner believes a telephonic interview would expedite prosecution of this application; Applicants invite the Examiner to call Applicants' representative as noted below.

Status of the Claims

Pending claims

Claims 1 to 43, are pending; claims 37 and 39 are withdrawn as being drawn to a non-elected invention; thus, claims 1 to 36, 38, and 40 to 43 are pending and under consideration.

Claims canceled in the instant amendment

Claims 14 to 26, 29 to 31, and 38, are canceled, without prejudice or disclaimer. Accordingly, after entry of the instant amendment, claims 1 to 13, 27, 28, 32 to 37, and 39 to 43, will be pending.

Outstanding rejections

Claims 1 to 36, 38, and 40 to 43, are rejected under 35 U.S.C. §112, first paragraph, enablement requirement. Claim 24 is rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse all outstanding objections and rejections of the claims.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the new and amended claims; see U.S. patent application publication no. 20030056231 ("the '231 publication"). For example, support for mouse strains made from transgenic mice of this invention can be found, inter alia, in paragraph [0032] of the '231 publication. Accordingly, Applicants submit that no new matter has been introduced and the instant amendment can be properly entered.

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

Group Restriction Requirement and Election

The Office alleged that the pending claims of the application are directed to two separate and distinct inventions under 35 U.S.C. §121; and in response Applicants elected Group I, drawn to drawn to a transgenic mouse. Group II is drawn to methods for screening therapeutic agents for the prevention or treatment of neurological disease comprising administration of therapeutic interventions to a transgenic mouse of this invention.

After the elected product claims have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims should be rejoined. Applicants note that Group II encompasses withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims.

Claim Objections under 35 U.S.C. §1.75(c)

Claim 23 was objected to for reasons set forth in the paragraph spanning pages 2 to 3, of the OA. The instant amendment addresses this issue; claim 23 is canceled, without prejudice or disclaimer.

Rejection Under 35 U.S.C. § 112, First Paragraph, enablement

Claims 1 to 36, 38, and 40 to 43 are rejected under 35 U.S.C. §112, first paragraph, enablement requirement, because the specification allegedly does not enable any person skilled in the art to which the invention pertains or with which it is most nearly connected to make the invention commensurate in scope with the instant claims, as set forth in detail in pages 3 to 4, of the OA.

The Office stated that the specification enables transgenic mice comprising a first transgenic sequence, integrated into the genome of the mouse, comprising a sequence encoding a wild type

human amyloid precursor protein (hAPP), 751 amino acid isoform (hAPP751), operably linked to a neuron-specific promoter; and a second transgenic nucleotide sequence, integrated into the genome of the mouse, comprising a sequence encoding a wild type human (h) α -synuclein operably linked to a second promoter (also a neuron-specific promoter); wherein the first and second transgenic nucleotide sequences are expressed, and the transgenic mouse develops amyloidosis, neurofibrillary tangles and intraneuronal accumulation of (h) α -synuclein (see, e.g., the first paragraph of the “enablement” section, page 2, of the OA).

As discussed in the telephonic interview of May 17, 2007, the instant amendment endeavors to amend the claims such that they only encompass this Office-acknowledged embodiment of the invention, thus, the instant amendment should address the Office’s concerns. Accordingly, the section 112, first paragraph rejection with respect to this concern can be properly withdrawn.

The Office also expressed concerns regarding the scope of claims 42 and 43, as discussed in detail in lines 16 to 19, of page 4, of the OA; e.g., because the claims did not specify a breeding partner. By amending the claims to encompass only inbred strains, the instant amendment should address this concern.

If the Office has any remaining concerns after entry of the instant claim amendment, please call Applicants’ representative at the number listed below.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 24 is rejected under 35 U.S.C. §112, second paragraph. The instant amendment addresses this issue; claim 24 is canceled, without prejudice or disclaimer.

CONCLUSION

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first paragraph. In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **220002065100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858 720 5133.

Dated: May 18, 2007

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